

REMARKS

Based on the above amendments and following remarks, this application is deemed to be in condition for allowance and action to that end is respectfully requested.

Summary Of Amendments To Claims

Applicant has amended the claims to, among other things, particularly define the Applicant's invention. No new matter has been added.

Information Disclosure Statement

The Examiner indicated that the listing of the references in the specification, e.g., U.S. Patent No. 3,626,899 to Spellman and U.S. Patent No. 4,800,677 to Mack, is not a proper information disclosure statement and unless the references have been cited by the Examiner on form PTO-892, they have not been considered. However, the Examiner based her rejections on Spellman and Mack (see below) and further lists the references on PTO-892. Accordingly, Applicant will not submit a separate information disclosure statement listing these references.

Response To Claim Rejections - 35 U.S.C. § 102

The Examiner rejected claims 1, 3, 7 under 35 U.S.C. § 102(b) as being anticipated by Mack (US 4800677). Applicant respectfully disagrees.

For a claimed invention to be anticipated by a single prior art reference pursuant to 35 U.S.C. § 102(b), the reference must teach every aspect of the claimed invention

either explicitly or impliedly. In other words, "a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *See Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Anticipation will not be found when the prior art is lacking or missing a specific feature or structure of the claimed invention.

Independent claim 1 defines Applicant's invention as follows: a pad, comprising: a top sheet; a backing sheet of fluid impervious material; one or more absorbent sheets disposed between the top and backing sheets; and a first frangible element which extends parallel to and partway along opposite sides of one dimension of the pad and a second frangible element located between the edges of the one dimension which extends perpendicular from the first frangible element thereby forming ties integral with said pad for tying said collection pad into a compact bundle for disposal. Claims 3 and 7 depend from claim 1, include all the limitations of claim 1 and add further limitations to claim 1.

The Examiner contends that Mack discloses Applicant's claimed frangible elements. However, such is not the case. Applicant's frangible elements are breakable elements, such as perforations, holes, slits, etc, that once broken/opened, separate a portion of the pad from the body of the pad to form ties integral with the pad. It is only when the frangible elements are opened/broken do the ties exist.

Mack on the other hand discloses existing ties that extend from the pad along opposite edges of the pad as shown in FIG. 1 of Mack, element 30. There is no disclosure of frangible elements, let alone frangible elements that form ties when the elements are opened/broken.

Therefore, based on the above remarks, Applicant respectfully submits that the claimed invention distinguishes over the applied prior art under 35 U.S.C. §102(b). Accordingly, Applicant submits that the grounds for the Examiner's rejections under 35 U.S.C. § 102(b) are overcome and withdrawal thereof is respectfully requested.

Response To Claim Rejections - 35 U.S.C. § 103

The Examiner rejected claims 5 and 6 under 35 U.S.C. 103(a) as being unpatentable over Mack; claim 4 under 35 U.S.C. 103(a) as being unpatentable over Mack in view of Spellman (US 3626899); and claim 8 under 35 U.S.C. 103(a) as being unpatentable over Mack in view of Ochi (US 5797347).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art references (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on an applicant's disclosure in the specification. *See In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Applicant respectfully submits that the cited reference/reference combinations – Mack, Mack in view of Spellman and Mack in view of Ochi – fail to teach or suggest, either expressly or inherently, all the limitations of the claims.

As discussed above, Mack fails to disclose the claimed frangible elements.

Neither are the frangible elements disclosed in Spellman and Ochi. Therefore, because the references fail to teach or suggest all the limitations of the claims, Applicant respectfully submits that the claimed invention distinguishes and is unobvious over the applied prior art under 35 U.S.C. §103. Accordingly, Applicant submits that the grounds for the Examiner's rejections under 35 U.S.C. § 103(a) are overcome and withdrawal thereof is respectfully requested.

Allowable Subject Matter

The Examiner indicated that claim 2 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant respectfully submits new independent claim 9 having all of the limitations of claim 2 and base claim 1. Accordingly, allowance of claim 9 is respectfully requested.

CONCLUSION

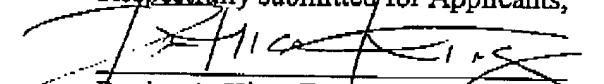
In view of the foregoing amendments and remarks, it is respectfully submitted that the application is in condition for allowance and accordingly, allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's Amendment and the case passed

to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

The Commissioner is authorized to charge any required fees, including any extension and/or excess claim fees, any additional fees, or credit any overpayment to Deposit Account 06-0923. Applicant claims small entity status. See 37 C.F.R. 1.27.

Respectfully submitted for Applicants,


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